

Applicants: Kenneth H. Rosen  
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### REMARKS

Claim 40 has been amended. Reconsideration is respectfully requested.

The Examiner has indicated that a new ground of rejection is set forth with respect to the present Office Action. The Examiner further notes that the new ground of rejection includes new prior art which predates Applicant's filing date. Applicant, therefore, assumes that the Examiner has found Applicant's previous submission under 37 C.F.R. §1.131 to be sufficient in removing U.S. Patent Application Publication No. 2003/0016894 to Sheha et al. This determination is gratefully acknowledged.

Independent claim 1 of the present application stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,185,426 to Alperovich et al. (hereinafter "Alperovich"). This determination is respectfully traversed.

Claim 1 of the present invention recites a method of transferring selective location information of a wireless calling party to a called party. The method includes receiving a telephone call at a telecommunications network from a wireless calling party, retrieving service information associated with the wireless calling party, wherein the service information includes restriction regarding the selective transfer of location information, and transmitting the selective location information to the called party.

A significant aspect of the invention claimed in claim 1 is that a system only transmits selective location information in accordance with instructions provided by the wireless calling party.

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The Examiner contends that Alperovich anticipates claim 1. The Examiner submits that, with respect to the limitation of transmitting selective location information to the wireless calling party, the "abstract teaches sending the calling party's location to the called party and Figures 1-3 show the network which retrieves information and decides to send the location information." Notwithstanding the Examiner's contention, it is respectfully submitted that neither the abstract of Alperovich nor the drawings of Figures 1-3 show Applicant's claimed features including retrieving service information associated with the calling party, where the service information includes instructions regarding the selective transfer location information and transmitting that selective location information to the called party.

The abstract of Alperovich which is solely relied upon by the Examiner for his anticipation rejection recites as follows:

A telecommunications system, and method for providing a called party with the location of the calling party. When a call is received by a switch serving the calling party, the location of the calling party is determined, which is then transmitted to the called party.

It is noted that nowhere in the abstract is there any discussion of transmitting only selective location information based on instructions provided to the telecommunications network. Alperovich is limited simply to providing location information to the called party. Moreover, nothing in Figures 1-3 of Alperovich provides any additional information regarding selectivity of information which can be transferred to the called party.

The Examiner is well aware that with respect to method claims, anticipation requires identity between the claimed process and the process of the prior art. The claimed process, including each step thereof, must be described either expressly or inherently in a single reference. *Glaverbel Society Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 U.S.P.Q. 2d 1496 (Fed. Cir. 1995). In relying on Alperovich, the Examiner has failed to find

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either in the abstract which the Examiner refers to or anywhere else in the reference, the steps of the presently claimed invention which includes retrieving service information including instructions regarding the selective transfer of location information and transmitting the selective location information to the called party. Failing to expressly or inherently disclose such limitations, Alperovich, as a matter of law, cannot be anticipatory of claim 1 of the present invention. Thus, it is respectfully submitted that claim 1, as well as claims 2-16, which depend therefrom are patentably distinct over Alperovich.

Independent claims 17, 32 and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich further in view of U.S. Patent No. 6,442,391 to Johansson et al. (hereinafter "Johansson") and U.S. Patent No. 6,662,014 to Walsh and U.S. Patent No. 6,675,071 to Zellner et al. (hereinafter "Zellner 1") or U.S. Patent No. 7,085,555 to Zellner et al. (hereinafter "Zellner 2"). This determination is respectfully traversed.

With respect to claims 17, 32 and 40, the Examiner contends that "Alperovich teaches a method of transferring selective location information of a wireless calling party to a called party comprising receiving a string of numbers from the wireless calling party whereby the string of numbers is inclusive of the parties telephone number." Furthermore, the Examiner acknowledges that Alperovich is silent on retrieving a code among a string of numbers wherein the code includes instructions regarding blocking the selective transfer of location information and transmitting the selective location information to a wireless calling party.

The Examiner summarizes each of the secondary references as follows. Johansson teaches location security (abstract). Walsh teaches a location privacy manager (abstract). Zellner 1 or Zellner 2 teach two different manners in which location blocking services prohibits the user's location from being transmitted to others (abstract). The Examiner then concludes it

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would be obvious to one skilled in the art at the time the invention was made to modify Alperovich such that a code is sent that activates location blocking.

The deficiencies of the Alperovich reference are discussed above. Alperovich fails to provide a network for storing service information wherein the service information includes instructions regarding the selective transfer of location information which is recited in each of independent claims 17, 32 and 40. Moreover, the Examiner acknowledges that Alperovich is also silent on retrieving a code among a string of numbers received which is also recited in independent claims 17, 32 and 40.

In the Examiner's citation to the secondary references, the Examiner relies on the abstracts thereof. None of the abstracts of the secondary references disclose that the selective service information instructions are provided by receiving a code from a string of numbers received from the calling party. While secondary references may each describe some limitations on the information which is transmitted to the called party, none of the abstracts disclose how the selectivity of the information is achieved. Thus, a combination of Alperovich with any or all of the secondary references still fails to disclose teach or suggest the invention set forth in independent claims 17, 32 and 40.

Moreover, one skilled in the art would not find the claimed invention to be obvious in view of the cited combination noting the deficiencies thereof. The five references cited by the Examiner, even in combination, fail to meet the limitations recited in independent claims 17, 32 and 40. The Examiner is engaging in impermissible hindsight reconstruction to support his conclusion that the claim limitations, not found in the cited combination, would be obvious one skilled in the art. *Loctite v. Ultraseal Ltd.* 781 F.2d 861, 228 U.S.P.Q. 90 (Fed. Cir. 1985). There is no teaching or suggestion in any of the references cited by the Examiner to provide for

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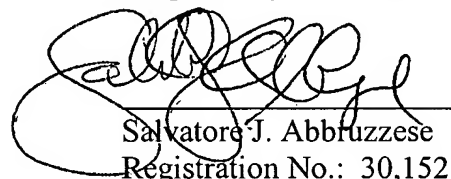
the selected transfer of information where instructions are received from a code among a string of numbers received from the calling party. Failing to find such suggestion, the claims of the present invention are believed to be patentably distinct over the cited combination.

Having responded in full to each rejection of the independent claims, it is respectfully submitted that the claims of the present application are patentably distinct over the cited references taken alone or in combination. Therefore, the application is deemed to be in condition for allowance. Favorable action is respectfully solicited.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 20-0776. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Should the Examiner have any questions regarding this response, the undersigned would be pleased to address them by telephone.

Respectfully submitted,



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